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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,101	04/21/2004	William J. Lutkus	0275G-000915	5999
27572 7590 09/13/2007 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			EXAMINER MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER
			3677	
			MAIL DATE	DELIVERY MODE
			09/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,101

Applicant(s)

LUTKUS ET AL.

Examiner

Katherine W. Mitchell

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 and 23-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/21/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

The Request filed on 8/28/2007 for Continuing Examination (RCE) under 37 CFR 1.114 is acceptable and an RCE has been established. Any previous finality is hereby withdrawn and a new action on the merits follows. Any newly-submitted claims have been added. An action on the RCE follows.

Information Disclosure Statement

The information disclosure statement filed 12/21/2006 has been considered. Please note that the provided EPO search report refers to "a corresponding EP application" but this case does not claim priority to any EP application, and examiner has no way of knowing the claim limitations of the EP application, other than the excerpts in the EPO form 2906.

Claim Formalities

Note that claims 23-27 are not "new" claims, but examiner understands the minor cut and paste error and thus considers the claims compliant.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-21,23-27 are rejected under 35 U.S.C. 103(a) as obvious over Lutkus et al. USP 6224311 in view of Whitford Worldwide's "11 Reasons why Chromium-free

Art Unit: 3677

Xylan® 5230 is specified by DaimlerChrysler, Ford, and General Motors”, hereafter called Whitford paper.

Re claims 11--18, 21, 23-25, 27: Lutkus USP 6224311 teaches a fastener assembly comprising:

a threaded fastener formed of a 1st metal

A metallic fastener insert

A receiving element

(see Fig 1 for these 3 items)

Wherein at least one of the inert or receiving element is formed of a 2nd metal (col 1 line 32-35; while the fastener is formed of a different metal in col 4 lines 54-55.) Col 3 lines 14-23 teach a fluoropolymer coating to reduce galvanic corrosion.

However, Lutkus is not specific that the fluoropolymer coating is chromate free. Whitford paper teaches the desirability of a chromate free coating to meet the US's "end of Life" Vehicle directive 2000/53/EC, further teaching that DaimlerChrysler, Ford, and General Motors all require such a chromate free coating for their fasteners. Further, XYLAN ® 5230 is specifically taught as advantageous specifically because it is a chromate free fastener coating, as required by the European Union, DaimlerChrysler, Ford, and General Motors. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Lutkus and Whitford paper before him at the time the invention was made, to modify Lutkus as taught by Whitford paper to include the chromate free fluoropolymer coating, in order to obtain environmentally acceptable, low friction, corrosion resistant coatings, as specifically taught in the Whitford paper, page 2. One would have been motivated to make such a combination because immediate

Art Unit: 3677

Market acceptance would have been obtained, as taught/suggested by Whitford paper.

Further, compliance with environmental and purchasing standards would be met.

Further Re claims 12-18, 21, 24-25, 27 : Lutkus teaches these properties in col 2 lines 1-33, col 3 lines 6-14, 15-44, and col 4 lines 1-3, 19-20, 54-55, and 65-68.

Re claims 19-20, 26: Lutkus teaches the use of tangless inserts in col 3 lines 1-4:

3

second ends, 36 and 38, respectively. At least one of the ends may be provided with a driving tang or notch for tangless embodiments for assistance in the installation or removal process.

Response to Arguments

3. Applicant's arguments filed 8/28/2007 have been fully considered but they are not persuasive.

4. Applicant is correct that a prior art teaching must anticipate or make obvious every limitation in a claim. However, applicant is claiming an apparatus - a fastener structure. In response to applicant's argument that the prior art does not teach the performance of the fastener in a specific test, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Further, applicant is arguing an inherent property of the chromate free coating, since no further specifics are provided. Applicant is arguing that the chromate free coating is advantageous for reasons other than environmental compliance, and has provided a declaration with test results showing the improved performance. First, the

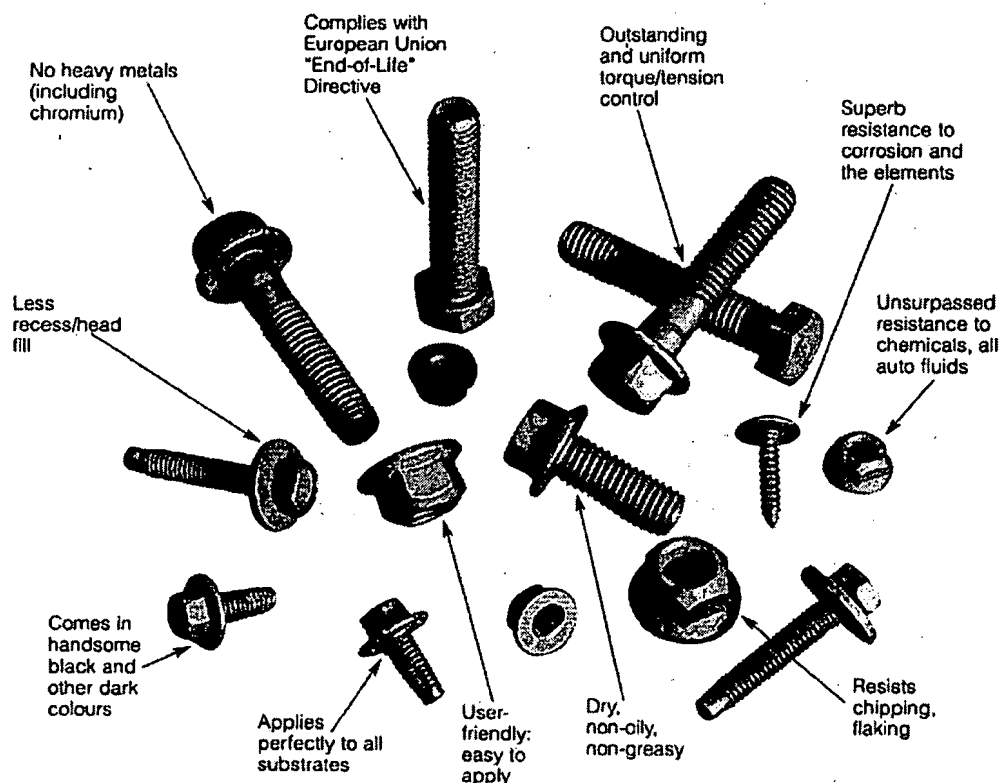
Art Unit: 3677

fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Again, the motivation to combine Lutkus and the chromate free coating of the Whitford paper is to comply with production and environmental requirements - if major manufacturers and the entire European marketplace require chromate free coatings, suppliers are certainly motivated to provide such coatings to keep these customers, or at least still be a possible supplier. The Whitford paper provides numerous advantages (motivations) to use chromate-free coatings on fasteners--note the "outstanding and uniform torque/tension control", "superb" corrosion resistance, "unsurpassed" chemical

Art Unit: 3677

resistance, along with ease of use and handling, and environmental advantages:



Once one is motivated to use chromate free coatings for environmental and marketing reasons, and does so, one would *THEN inevitably realize any improved performance in the prevailing torque test, since identical structures perform identically.* The fact that there may or may not be unexpected torque-test results is irrelevant—the motivation to combine is NOT to improve torque test results, but to comply with EU environmental regulations, and thus maintain the potential market. Further, environmental problems forbidden in the EU would likely at least cause consideration that the chromate coatings could be a problem in the US, and mitigating environmental problems is important for both public relations and minimizing potential litigation and remediation costs in the U.S.

Response to Amendment

Art Unit: 3677

5. The Declaration of Mr. Lutkus under 37 CFR 1.132 filed 8/28/2007 is insufficient to overcome the rejection of claims 11-21,23-27, based upon Lutkus et al. USP 6224311 in view of Whitford Worldwide's "11 Reasons why Chromium-free Xylan® 5230 is specified by DaimlerChrysler, Ford, and General Motors", hereafter called Whitford paper as set forth in the last Office action because examiner is not considering that the motivation of one of ordinary skill in the art to combine Lutkus and the Whitford paper is based on performance in a torque test. Examiner agrees that if the only motivation to combine Lutkus and the Whitford paper were the performance of the coated inserts in a prevailing torque test, then the additional tests do indicate that there may be unexpected results in said tests. However, this is not germane in this situation. Examiner maintains that the motivation to combine Lutkus and the Whitford paper has nothing to do with performance in torque tests. The Whitford paper is clear that the 3 major American car manufacturers – DaimlerChrysler, Ford, and General Motors, have all specified environmentally-friendly, chromium-free fastener coating XYLAN 5230 to comply with EU "End of Life" Vehicle Directive (2000/53/EC) environmental regulations (page 3 of 3), since all 3 produce vehicles for EU markets. Further, the Whitford paper notes that this chromium-free coating also provides additional benefits, (chemical resistance, corrosion resistance, page 2 of 3) and thus the motivation is completely unrelated to torque test performance. ONCE ONE IS MOTIVATED TO USE CHROMATE FREE COATINGS, other inevitable benefits may be uncovered, but these benefits do not change the fact that the motivation to combine was environmental compliance to maintain markets. However, note that page 1 of 3 of the Whitford paper

Art Unit: 3677

explicitly states [XYLAN 5230] "Primary function is to facilitate uniform driving torque while providing corrosion resistance", so it is certainly not unexpected that torque test performance is enhanced. However, examiner cannot stress enough that the "PRIME MOTIVATOR" for Xylan 5230 was to comply with EU environmental directives, and maintain markets (page 3 of 3), and it is this motivation that examiner considers to be the motivation to combine Lutkus and the Whitford paper.

Conclusion

This is a Request for Continuing Examination of applicant's earlier application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3677

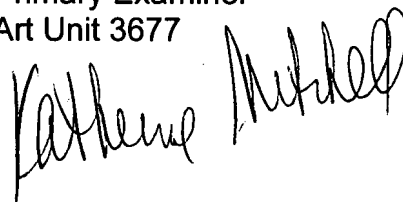
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9/10/2007

Katherine W Mitchell
Primary Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to read "Katherine Mitchell", is written over the printed name and title.